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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION NO.1174 OF 2005
IN
SUIT NO.1112 OF 2005

USV Limited ... Plaintiffs

V/s.

Cadila Pharmaceuticals Ltd. ... Defendants

Mr.Ashish Kamat for Plaintiffs
Mr.A.M. Abdi with Mr.Satya Prakash for Defendants

CORAM: **SMT.NISHITA MHATRE, J.**

DATED: **JUNE 26, 2006**

P.C.:

. The Plaintiffs have filed the present Motion for an injunction against the Defendants from manufacturing the medicinal and pharmaceutical preparation under the Trade Mark which the Plaintiff contends is similar to their registered trade mark "FAMOTIN". The Plaintiffs contend that they have been manufacturing the medicinal preparation "FAMOTIN" from 1989 onwards. The Plaintiffs noticed that the defendants marketed their medicinal product under the name "FAMODIN" since the year 2000. The Plaintiffs have contended that the two marks "FAMOTIN" and "FAMODIN" are deceptively similar. By using the mark "FAMODIN", the Defendants have infringed the Plaintiffs' copyright in the word mark. The Plaintiffs have also complained that the Defendants have been passing off their medicinal preparations as the Plaintiffs' products.

2. There is no doubt that the two marks are deceptively similar and there is a phonetic similarity between the two marks. The possibility of confusion between the two marks cannot be ruled out. As held in the case of *Cadila Health Care Ltd. v/s. Cadila Pharmaceuticals Ltd.*, **AIR 2001 SC 1952**, when the Court considers the case of infringement in respect of the medicinal and pharmaceutical preparations, a more rigourous test must be applied to the products. In my view, there is a clear possibility of confusion in the minds of the customers and the traders. The degree of resemblance between the two trade marks is very high especially since there is phonetic similarity.

3. Ad-interim relief in terms of prayer clauses (a) and (b) have already been granted on 27.4.2005. The Defendants have filed a reply indicating that they were informed by the trade mark registry on 5.3.2002 when search was taken by them that there was no identical or deceptively similar registered mark. The Defendants contend that they had been manufacturing and marketing the product "FAMODIN" from 2001 onwards. According to them, the word mark used by them was coined from the word "Famotidine" which is the drug used for the treatment of acid peptic disorder. According to the Defendants, there are several companies using the drug "Famotidine" and that names of those products are coined from the word "Famotidine". In my view, this reply

filed by the defendants does not in any manner indicate that the Plaintiffs' case should not be accepted. The Plaintiffs' use of their trade mark is prior in point of time and hence, the ad-interim relief granted must be confirmed.

4. The learned Advocate for the Defendant relies on the judgments in *Aristo Pharmaceuticals ltd. v/s. Wockhardt Ltd.,* **2001(21) PTC 139(SC)**; *Khandelwal Laboratories Ltd. v/s. FDC Ltd.,* **2001(2) (21) PTC 864 (Del);** *Sami Khatib & Anr. v/s. Seagull Labs (I) Pvt. Ltd. & Anr.,* **2002 (24) PTC 165 (Del.);** *Aviat Chemicals Pvt. Ltd. & Anr. v/s. Intas Pharmaceuticals Ltd.,* **2001 (21) PTC 601 (Del);** *Rupee Gains Tele-Times Private Ltd. v/s. Rupee Times,* **1995 (15) PTC 384 (Del);** *Parle Products Limited v/s. Bakemans Industries Limited,* **1998 PTC (18);** *Regency Sanitary Ware Pvt. Ltd. v/s. Madhusudan Industries Ltd.,* **2001 (21) PTC 422 (Guj.).**

5. In the case of *Aristo Pharmaceuticals Ltd.* (supra), the Supreme Court considered whether there was a deceptively similar mark used. The Supreme Court held that an injunction could have been granted only after the Court allowed the parties to lead evidence as the facts alleged by appellant therein were not exactly admitted by the Respondent. The Apex Court held that since the parties disputed the facts, it was necessary to allow the parties to lead evidence. In the present case, no such application has been made by the Defendant

before this Court to prove the facts.

6. In the case of *Khandelwal Laboratories Ltd.* (supra), the Delhi High Court was considering the trade mark "CEFI" which is designed and derived from chemical bound cefixime. The Defendant was using a trade mark which according to the Plaintiff was deceptively similar to its mark. The Delhi High Court refused to grant injunction since the Plaintiff's use was just two months prior to the date of inception of the suit. The Delhi High Court observed that it was a shortest user possible in an action for passing off. In the present case, there is evidence on record to show that the Plaintiffs' user of their its trade mark "FAMOTIN" is prior in point of time than the defendants. The Plaintiffs have been using the mark for over 11 years and it was registered in 2001. Therefore, this judgment has no relevance to the facts before me.

7. In the case of *Sami Khatib & Anr.* (supra), the Delhi High Court observed that a mere phonetic similarity is not sufficient. The ultimate test is whether a trade mark used by the defendant is deceptively similar. The resemblance can be phonetic, visual or in the basic idea represented by the plaintiff's trade mark. In the present case, there can be no doubt that there is phonetic similarity. Visually also the trade mark is the same or in any case

deceptively similar. There is a difference of only one alphabet in both the marks. Hence, this judgment has no relevance to the case before me.

8. In the case of *Aviat Chemicals Pvt. Ltd. & Anr. (supra)*, the Delhi High Court held that in an action for passing off where a generic word is used as a prefix suggestive of the ailments the drug treats and the sale of the products is through qualified chemists, the plaintiffs cannot secure an injunction against the defendant and no action for passing off lies. In the present case, the word "FAMOTIN" is a registered trade mark of the plaintiffs. The Plaintiffs have contended there is infringement of its copyright in its registered trade mark. I am satisfied that there is an infringement and injunction must follow, although the word may be derived from the generic word "Famotidine". The tests to be applied in a case of infringement are different from those applicable in a passing off action. Therefore, this judgment is of no avail to the Defendants. Similarly, the case of *Rupee Gains Tele-Times Pvt. Ltd.* (supra) was a case for passing and not of infringement and therefore, not relevant.

9. In the case of *Parle Products Ltd. (supra)*, the Madras High Court observed that there is no likelihood of deception and therefore, the plaintiff was refused interim injunction. It was observed that the words used contained a different prefix with a different get up,

dissimilar packaging and shape of the products and therefore, there was no case made out of deception.

10. The Gujarat High Court has considered a case where the products were made of Ceramics and the plaintiffs used the word "CERA" from generic word CERAMICS in *Regency Sanitary Ware Pvt. Ltd. (supra)*. The Gujarat High Court held that the word used by the defendant in that case was visually distinct and different from the trade mark used by the plaintiffs and hence, refused to grant any injunction. Both these judgments are not applicable to the facts in this case. As aforesaid the test in respect of medicinal products is more strict, to avoid confusion and deception.

11. Notice of Motion is therefore made absolute in terms of prayer clauses (a) and (b) except the bracketed portions.